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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,213	12/04/2001	Fred H. Burbank	9619-1011	7928
7590	03/23/2005		EXAMINER	
Edward J. Lynch Coudert Brothers LLP One Market Plaza Spear Street Tower ste 2000 San Francisco, CA 94105			FOREMAN, JONATHAN M	
			ART UNIT	PAPER NUMBER
			3736	

DATE MAILED: 03/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/010,213

Applicant(s)

BURBANK ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-11, 13, 15, 19-22, 24-29, 31, 32, 35, 36, 39, 40, 43, 45, 46 and 49-68 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 32, 51, 53, 61 and 65-68 is/are rejected.
- 7) ☒ Claim(s) 56 and 62-64 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20011204.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

Continuation of Disposition of Claims: Claims withdrawn from consideration are 3-11,13,15,19-22,24-29,31,35,36,39,40,43,45,46,49,50,52,54,55 and 57.

DETAILED ACTION

Election/Restrictions

1. Claims 3 – 11, 13, 15, 19 – 22, 24 – 29, 31, 35, 36, 39, 40, 43, 45, 46, 49, 50, 52, 54, 55 and 57 – 60 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 1/13/05.

Information Disclosure Statement

The information disclosure statement filed 12/4/01 complies with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609. It has been placed in the application file, and the information referred to therein has been considered by the examiner as to the merits.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 32, 51, 53, and 65 – 68 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,423,770 to Yoon.

In regards to claims 32, 51, 53 and 65 – 68, Yoon discloses a tissue acquisition instrument including a distal end adapted for entry into a patient's body ; a cutting element (140) disposed on the instrument for cutting tissue; and a mechanical fixation element disposed on the distal end for

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securing the instrument at a predetermined location (Col. 14, lines 9 – 20). The mechanical fixation element includes a pair of bendable legs (139) with each leg having a hinged (141) linkage.

4. Claim 61 is rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,735,847 to Gough et al.

In regards to claim 61, Gough et al. discloses an instrument (Figure 8) including an elongated shaft (14) having a longitudinal axis and a distal end adapted for entry into a patient's body (Col. 5, lines 8 – 10); a tissue cutting element (16) disposed on the elongated shaft proximal the distal end for cutting tissue surrounding the shaft; and a mechanical fixation assembly (16) on the elongated shaft proximal the distal end and has a pair of outwardly bendable legs for securing tissue (Col. 9, lines 11 – 17; 37 – 40).

5. Claims 65 – 68 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,879,357 to Heaton et al.

In regards to claims 65 – 68, Heaton et al. discloses an instrument (Figure 37) comprising an elongated shaft having a longitudinal axis and a distal end (211) adapted for entry into a patient's body; and a mechanical fixation assembly on the shaft having a pair of outwardly bendable legs (273) for securing a tissue specimen. The bendable legs include first and second leg segments (273) having a hinged linkage (275) therebetween.

Allowable Subject Matter

6. Claims 56 and 62 – 64 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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